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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,845

10/17/2003

Antonella Pesce

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EXAMINER

ARNOLD, ERNST V

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

07/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,845	<b>Applicant(s)</b> PESCE ET AL.	
	<b>Examiner</b> ERNST V. ARNOLD	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/20/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1-9 and 18 have been cancelled. Claims 10-17, 19 and 20 are under examination.

#### **Withdrawn rejections:**

Applicant's amendments and arguments filed 4/8/08 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below is herein withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-17, 19 and 20 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,506,958) in view of Schneider et al. (US 4,583,980) and Furman (US 5,451,404).

Applicant claims a hygienic article comprising a composition comprising a cooling agent with an ester derivative.

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

Williams teaches a signal tampon with an indicator designed to provide a sensory signal to the user (Abstract). The sensory signal can be a cold sensation produced by a cold sensation material such as menthyl lactate (a cyclohexyl structure), menthol, ethanol or combinations thereof (Column 4, lines 1-10 and claim 16). It is the Examiner's position that the teaching of Williams suggests combining a first cooling agent, menthol, with a second cooling agent such as menthyl lactate.

Schneider teaches a sanitary hygiene product having odor preventing properties that contains triethyl citrate (claims 1-4; column 3, lines 29-49 and column 4, lines 1-15). Schneider teaches that the triethyl citrate can be mixed with perfume oils (column 3, lines 35-49). Schneider teaches that triethyl citrate has the strongest odor preventing effect and best suitability for practical application (column 3, lines 2-5).

Furman teaches cooling compositions comprising a ketal and a secondary coolant, which may be menthol, carboxamides or mixtures thereof (Abstract; column 2, line 28 through column 5, line 53 and claims 1-10). The compositions can be applied to the body (column 5, line 57 and include toilet articles (column 6, lines 11-12 and claim 8). The composition can be formulated into a carrier such as solids, liquids, emulsions, foams and gels (column 6, lines 19-32).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

1. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with an ester derivative or other cooling agents such as ketals and carboxamides. This deficiency in Williams is cured by the teachings of Schnieder and Furman.

2. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon with a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100.

3. The difference between the instant application and that of Williams is that Williams do not expressly teach the signal tampon wherein the cooling agent or a mixture thereof is present at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is present at a level of from 99.9% to 0.1% by weight of the total composition.

4. The difference between the instant application and that of Williams is that Williams do not expressly teach the article wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

**Finding of prima facie obviousness**

**Rational and Motivation (MPEP 2142-2143)**

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add an ester of citric acid, such as triethyl citrate, as suggested by Schnieder, or other cooling agents as suggested by Furman, to the hygienic article, tampon, of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Schneider teaches that triethyl citrate is the best suitable odor preventing agent for this application. In addition: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, Furman establishes a wide variety of other cooling agents which could be utilized in the tampon of Williams.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add a first cooling agent and a second cooling agent in a weight ratio of 1/1 to 1/100 to the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams suggests combining cooling agents and it is merely routine optimization for one of ordinary skill in the art to arrive at the ratio of 1/1 to 1/100 by weight of the cooling agents.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the cooling agent or a mixture thereof at a level of about 0.1% to about 99.9% and wherein the ester derivative or a mixture thereof is at a level of from 99.9% to

0.1% by weight of the total composition in the composition of Williams and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Williams and Schneider provide the ingredients and it is merely routine optimization by one of ordinary skill in the art to arrive at the instantly claimed amounts. In fact Schneider provides guidance on how to apply the triethyl citrate in column 3, lines 12-34).

4. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make the article of Williams wherein the composition is suitable for topical application to the external surface of a mammal in the form of a cream, lotion, emulsion, dispersion, gel, foam, oil, ointment or powder.

One of ordinary skill in the art would have been motivated to do this because Williams teaches that the indicator can be in a hydrogel, which is a type of gel (Column 3, lines 51-52).

**Summary:** The art teaches the use of triethyl citrate and cooling agents in sanitary hygienic articles. It is merely ordinary innovation to combine triethyl citrate and a cooling agent into a hygienic article. The expected result remains a signal tampon. From recent case law: “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

**Response to arguments:**

Applicant asserts that there is no motivation to combine the references for three reasons. First, Williams is directed to a signal tampon with a rapid impulse release whereas Schneider is directed to sustained odor suppression. Therefore one skilled in the art would not be motivated to combine the sustained odor suppression teachings of Schneider with the impulse release of Williams. Second, modifying Williams as taught by Schneider would render Williams unsatisfactory for its intended purpose. Third, the proposed modification or combination of Williams with Schneider would change the principle of operation of Williams.

Respectfully, the Examiner cannot agree with these assertions. Essentially, Applicant argues that one would not combine the fast signal of the primary reference with the sustained odor suppression of triethyl citrate in the secondary reference because of an asserted decrease in signal intensity caused by the combination. It is the Examiner's position that tampons are left in place until they are full and during that period sustained odor suppression would be desirable. Applicant asserts that if triethyl citrate is added to the tampon of the primary reference then the signal would be dampened and result in lack of a distinct signal that leakage is about to occur. It is the Examiner's position that this is merely an assertion with no proof that the combination would change the principle of the primary reference. The Examiner agrees that the distinctness and intensity of the signal provides the benefit in the primary reference of Williams but the primary reference would also benefit from odor prevention as taught by the secondary reference.



Applicant's arguments are not persuasive and the rejection is maintained.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

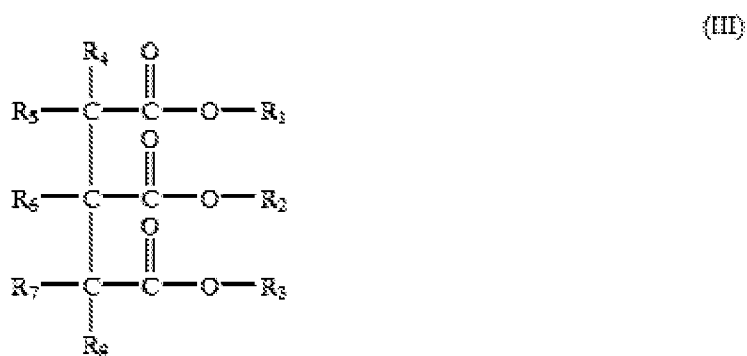
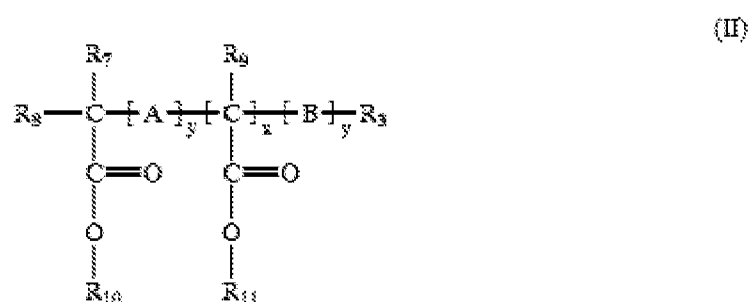
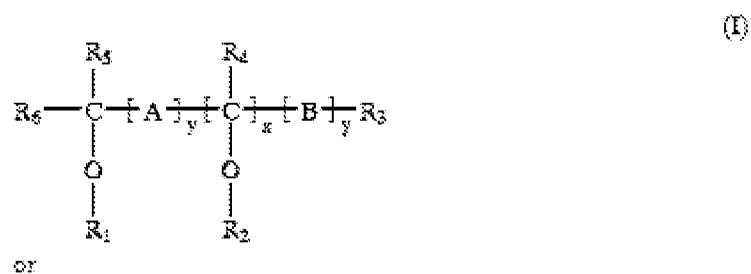
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,972,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the instant application is embraced by the claimed subject matter in the patent.

Claim 1 of US 6,972,010 is drawn to an absorbent article comprising an agent able to convey a perception to the wearer and a delivery system for containing and delivering the agent to the skin. Claim 1 of US 6,972,010 also recites wherein the delivery system comprises an alcohol or ester derivative of the following formulae:

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Thus, the instant ester derivatives are fairly taught in US 6,972,010. US 6,972,010 does not expressly claim the article and agent in the claim language. The Examiner notes that: MPEP § 804 (II) states, “When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft*

*Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.” (*emphasis added*). “Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).”

Therefore, the Examiner looked to the specification for guidance on the type of agent and type of article. The article is described as being panty liners, for example, with topsheets and backsheets fully discussed (Column 25, line 1 through column 33, line 57). The agent is disclosed as being derivatives of ketals, carboxamides, cyclohexanol, cyclohexyl as well as a number of oils such as peppermint oil that can convey a perception, freshness sensation, to the wearer (Column 7, line 13 and 46 through column 14, line 60). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over US 6,972,010 due to the overlap in claimed subject matter as described above.

II. Claims 10-17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-6 and 8-13 of copending Application No. 11/106,402. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter is embraced by the subject matter of the copending application. The copending application claims an absorbent article, such as a panty liner, comprising an agent able to convey a perception to the wearer wherein the agent is a cooling agent selected from the group consisting of ketals, carboxamides, cyclohexyl derivatives, etc....(Claims 2-5). The article comprises a delivery system which is an emollient containing

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composition comprises from about 0.1% to about 99.9% by weight of the agent and from about 99.1% to about 0.1% by weight of the emollient and the delivery system comprises triethyl citrate (claims 8-11). The article comprises a topsheet (claims 12-13). The article comprises menthol as a first cooling agent in combination with a second cooling agent (Claim 6). One of ordinary skill in the art would have recognized the obvious variation of the instant invention over the copending claims due to the overlap in subject matter as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Response to arguments:**

Applicant has agreed (see remarks of 4/8/08) to submit terminal disclaimers upon indication of allowable subject matter. Until such a time the claims remain rejected.

***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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